

R E M A R K S

Prior to entry of this Amendment:

- Claims **49-74** were pending in the present application
- Claims **49-74** stand rejected

Upon entry of this Amendment, which is respectfully requested for the reasons set forth below:

- Claims **49-62, 70, and 73-80** will be pending (21 claims total)
- Claims 63-69, 71 and 72 will be cancelled
- Claims **75-80** will be added
- Claims **49, 70, 73 and 74** will be amended
- Claims **49, 61-62, 73, 74 and 80** will be the only independent claims (6 independent claims)

A. RCE

This Amendment and Response is being filed in response to a Final Office Action. A Request for Continued Examination (RCE), along with the appropriate fee, is being filed concurrently to ensure consideration of this Amendment and Response.

B. Telephone Interview with SPE Millin

Our representative had a helpful telephone conversation with SPE Millin on December 1, 2004. We are grateful to SPE Millin for extending this courtesy.

SPE Millin stated that the amendment to Claim **49** discussed with Examiner Colbert on November 30, 2004, (i.e., to recite *calculating, by a processing device, a payment...*) would be sufficient to overcome the Section 101 rejection.

SPE Millin stated that it is not necessary to also amend the preamble of Claim **49** to recite a “computerized” method.

SPE Millin also indicated that he would discuss the issue with Examiner Colbert. If either SPE Millin or Examiner Colbert wishes to discuss this issue with us further, we encourage them to contact the undersigned.

C. Telephone Interview with Examiner Colbert

We would like to thank the Examiner for the helpful telephone conversation held on November 30, 2004, with our representative.

The Examiner and our representative generally discussed:

- (i) Cunningham and Weiss;
- (ii) the present § 101 rejections; and
- (iii) whether any claim is rejected under § 112, second paragraph, as being indefinite.

C.1. Discussion of Cunningham: Examiner could not identify where Cunningham teaches *an offer to provide a payment to a customer if the customer agrees to the modification (from a first value to a second value) of the parameter*

Our representative stated that Cunningham does not appear to recite *an offer to provide the payment to the customer if the customer agrees to the modification (from a first value to a second value) of the parameter* in the cited portions or anywhere else in the reference, and does not even appear to recite *an offer to provide a payment to a customer*, as recited in independent Claim 49.

The Examiner stated that Cunningham discloses “offers” in the only portions cited by the Examiner in the Office Action with respect to these limitations (Col. 5, lines 6-67; Fig. 3; Col. 6, lines 1-11; Fig. 4).

Our representative responded that the offers of Cunningham referred to by the Examiner do not appear to suggest an offer *to provide a payment to a customer*, much less *an offer to provide a payment to the customer if the customer agrees to a modification*.

The Examiner stated that during the Telephone Interview she was unable to identify anything related to *an offer to provide a payment to the customer if the customer agrees to a modification* in the cited portions.

The Examiner stated that she would have to review all of Cunningham again to determine the portion she was relying on as teaching *an offer to provide the payment to the customer if the customer agrees to the modification (from a first value to a second value) of the parameter*.

C.2. Discussion of Weiss: Examiner could not identify where Weiss teaches presenting a customer with an offer to modify the at least one term of a credit account

Our representative stated that Weiss does not appear to recite *presenting a customer with an offer to modify the at least one term of a credit account* in the cited portions or anywhere else in the reference, as recited in independent Claim 63.

The Examiner stated that during the Telephone Interview she was unable to identify anything related to *presenting a customer with an offer to modify the at least one term of a credit account* in the only portions cited in the Office Action with respect to these limitations (Fig. 5M; Col. 19, lines 7-26).

The Examiner stated that she would have to review all of Weiss again to determine the portion she was relying on as teaching *presenting a customer with an offer to modify the at least one term of a credit account*.

C.3. Discussion of § 101 rejections

C.3.a. Only Claims 49-60, 62-72 and 74 are rejected under § 101

The Examiner clarified that only Claims 49-60, 62-72 and 74 are rejected under § 101. The Examiner clarified that Claims 61 and 73 are directed to statutory subject matter and are not rejected under § 101. We are grateful for this clarification.

C.3.b. The Examiner would require “computerized” method to be recited in the preamble even if “technology” is recited in the body of the claim to perform a method step

We note that our representative discussed this issue with SPE Millin on December 1 (see above). According to SPE Millin, the preamble does not also need to be amended if Claim 49 is amended as proposed.

During the Telephone Interview, the Examiner stated that our proposed amendment to recite *calculating, by a processing device, a payment...* in Claim 49 would be insufficient to overcome the § 101 rejection unless the preamble was also amended to recite a “computerized” method. The Examiner also stated that our proposed amendment to recite *determining, by a processing device, at least one term of the credit account* in Claim 63 would be insufficient to overcome the § 101

rejection unless the preamble was also amended to recite a “computerized” method.

Our representative did not agree with the necessity of amending the preamble.

C.3.c. Claims 62 and 74

Our representative asked the Examiner to explain the statement in the Office Action (page 11): “Independent claims 62 and 74 do not claim the method steps as being embodied in a computer readable medium encoded with a program for implementing the method.”

The Examiner said that the statement was self-explanatory.

Our representative noted that each of independent Claims **62 and 74** recites: “*A medium encoded with a program for implementing a method, said program for directing a device to perform the steps of:....*”

The Examiner then said that by her statement she intended to indicate that each of Claims **62 and 74** needs to be amended to recite “technology” in the “body” of the claim in order to overcome the § 101 rejections.

The Examiner agreed with our representative that each of Claims **62 and 74** is directed to a medium encoded with a program for directing a device.

C.4. No claim is rejected as being indefinite under § 112, second paragraph

Our representative noted that the Examiner asserts in the Office Action that the terms “value” and “parameter” “are considered to be indefinite” (page 14).

Our representative asked the Examiner to clarify whether any claim is rejected under § 112, second paragraph as being “indefinite.”

The Examiner stated that no claim is rejected under § 112, second paragraph. We are grateful to the Examiner for this clarification.

While no formal agreement was reached with respect to patentability of any claim, we are grateful for the opportunity to discuss the present application with the Examiner.

D. Response to Examiner's Interview Summary

In Examiner Colbert's Interview Summary mailed December 9, 2004, the Examiner states:

The Examiner asked the Applicants' Representative, Mr. Downs to point out in the claim the inventive concept. Mr. Downs referred the Examiner to the last step of claim 49 in particular "a customer associated with the credit account...the offer comprises an offer to provide payment to the customer if the customer agrees to the modification parameter" and claim 63 reading "...that a customer associated with a credit account is dissatisfied with the credit account; determining at least one term of the credit account; and presenting the customer with an offer to modify the at least one term of the credit account."

The Examiner's Interview Summary might imply that Mr. Downs' reference to particular steps was in response to the Examiner's request to point out "the inventive concept." It was not.

Accordingly, we wish to clarify the record. Mr. Downs never "pointed out" any particular subject matter as being the "inventive concept." In fact, when asked by the Examiner to point out the "inventive concept," Mr. Downs replied that he did not know what the Examiner meant by "inventive concept." Mr. Downs explained to the Examiner that all of the language of any particular claim defines the particular claimed subject matter.

Then Mr. Downs asked the Examiner to consider language in several steps (not just the last step) of Claim 49 while he described some exemplary embodiments encompassed by Claim 49. At no time did Mr. Downs refer to any step as the "inventive concept" of any particular embodiment or of the present invention as a whole.

With respect to Claim 63, Mr. Downs again made reference to all of the steps of Claim 63 in discussing that claim. At no time did Mr. Downs refer to any particular step(s) as the "inventive concept."

In summary, none of the particular language to which Mr. Downs referred the Examiner while discussing exemplary embodiments of the present invention is to be understood as being the "inventive concept" (whatever that may mean) or "essential" to any embodiment of the present invention.

E. Claim Amendments

No new matter has been added by any amendment.

E.1. Claim 70 has been amended

Claim 70 has been amended to recite expressly all of the limitations of now-cancelled Claim 63 that were already implicitly recited in Claim 70 due to its dependency on Claim 63. Such incorporation cannot affect the scope of the subject matter of Claim 70 and is clearly not a narrowing amendment.

Claim 70 has also been amended without prejudice to recite that the step of *determining at least one term of the credit account is by a processing device*. We do not believe that this amendment is necessary for Claim 70 to be statutory under Section 101; Claims 63 and 70 were already directed to statutory subject matter. We intend to pursue the subject matter of Claim 70, as originally filed, in a continuing application.

E.2. Independent Claims 73 and 74 have been amended

Although we do not necessarily agree with the Examiner's Section 102 rejection, each of independent Claims 73 and 74 has been amended without prejudice to include features generally directed to *determining a payment to offer to the customer in exchange for modifying the at least one term and wherein the offer to modify the at least one term of the credit account includes an offer of the payment*.

As discussed in the previous Response, we do not believe that the cited references teach all of the features of Claims 73 and 74 as originally filed. We make this Amendment solely in order to expedite allowance of the present application. We intend to pursue the subject matter of Claims 73 and 74, as originally filed, in a continuing application.

E.3. Claim 49 now recites a processing device

Claim 49 has been amended without prejudice to recite that the step of *calculating is by a processing device*. We do not believe that this amendment is necessary for Claim 49 to be statutory under Section 101; Claim 49 was already directed to statutory subject matter. We intend to pursue the subject matter of Claim 49, as originally filed, in a continuing application.

E.4. New Claims 75-80 have been added

Each of new Claims **75-79** depends from now-independent Claim **70**. Claims **75-79** are believed to be allowable for at least the same reasons as Claim **70**, discussed below.

New independent Claim **80** recites *calculating, by a processing device, a payment, determining a current value of a parameter of an existing credit account, and in which the offer comprises an offer to provide the payment to the customer if the customer agrees to a modification of the parameter from the current value to the value that is not the same as the current value*. Claim **80** is believed to be allowable for at least the same reasons as Claim **49**, as discussed further below.

F. Section 101 Rejection of Claims 49-60, 62-72 and 74

As the Examiner clarified in the Telephone Interview, only Claims **49-60, 62-72 and 74** are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. [Office Action, page 2].

Claims 63-69 and 71-72 have been cancelled; their rejection is moot.

The amendments made herein (discussed below) are believed to be sufficient to overcome the reasons the Examiner is rejecting Claims **49-60, 62, 70 and 74** under § 101.

F.1. Claims 49-60 and 70

Claim **49** has been amended to recite *calculating, by a processing device, a payment....* Although we do not believe any such amendment is necessary, we submit that it is sufficient to overcome the Examiner's rejection.

Also, Claim **70** now recites *determining, by a processing device, at least one term of the credit account*. Although we do not believe any such amendment is necessary, we submit that it is sufficient to overcome the Examiner's rejection.

Accordingly, we request that the Examiner withdraw the Section 101 rejection of Claim **49** (and claims **50-60** dependent therefrom) and Claim **70**.

F.2. Claims 62 and 74

The Examiner rejects Claims **62 and 74** for reasons that are not clear (see page 11). The Examiner indicated in the Telephone Interview that the claims must recite “technology” in the “body” of the claims.

We note that each of Claims **62 and 74** is directed to a medium encoded with a program for directing a device to perform a method including recited steps.

Accordingly, it is not clear why the Examiner finds it relevant that the steps could be performed in the mind of a user or by use of pencil and paper (see page 10). Even if the steps, on their own, could be performed mentally or by use of pencil and paper, the claims are explicitly directed to articles of manufacture for directing a device to perform the recited functionality, and not to the methods alone.

Claims **62 and 74** are clearly directed to statutory subject matter. We respectfully request that the Examiner withdraw the Section 101 rejection of Claims **62 and 74**.

F.3. Response to Arguments

We do not agree with any of the Section 101 rejections for the reasons stated in our previous Response mailed May 4, 2004. Specifically, the proper legal test for the presence of statutory subject matter is only that a claimed process or apparatus produce a “useful, concrete and tangible result”. See, e.g., State Street Bank & Trust Co. v. Signature Fin. Group, Inc., 149 F.3d 1368, 1375, 47 USPQ2d 1596, 1602 (Fed. Cir. 1998), cert. denied, 525 U.S. 1093, 142 L. Ed. 2d 704, 119 S. Ct. 851 (1999) (“For purpose of our analysis, as noted above, claim 1 is directed to a machine programmed with the Hub and Spoke software and admittedly produces a ‘useful, concrete, and tangible result.’ ... This renders it statutory subject matter, even if the useful result is expressed in numbers, such as price, profit, percentage, cost, or loss.”); AT & T Corp., 172 F.3d 1352, 1361 (Fed. Cir. 1999) (“[T]he focus is understood to be not on whether there is a mathematical algorithm at work, but on whether the algorithm-containing invention, as a whole, produces a tangible, useful, result.”).

Also, we submit that the actual standards applied for determining whether a claim is “within the technological arts” are one or more of:

- (i) “all of the recited steps can be performed in the mind of the user”;

(ii) “all of the recited steps can be performed...by use of a pencil and paper”; and

(iii) no “computer performs the recited steps.”

[Office Action, pages 3, 10].

No combination of these reasons (i) – (iii) is sufficient basis to reject any claim, each of which produces a useful, concrete and tangible result.

With respect to reason (iii), despite the Examiner’s implication, there is no indication that any court has ever interpreted “technological arts” to demand reciting of a “computer” in every method claim. The Examiner must concede that there are many fields of “technology” in which applicants properly may seek a patent that do not involve “computers.”

With respect to reasons (i) and (ii), we note that these standards (not performable by the mind of a user or by use of a pencil and paper) is contrary to law. See, e.g., Alco Standard Corp. v. Tennessee Valley Authority, 808 F.2d 1490, 1496, 1 USPQ2d 1337, 1341 (Fed. Cir. 1986) (“The inclusion in a patent of a claim to a process that may be performed by a person, but that is also capable of being performed by a machine, is not fatal to patentability. The presence of the steps of correlating and combining, which a machine is capable of doing, does not invalidate a patent.”); See, also, Musco Corp. v. Qualite, Inc., Civ. Application, 106 F.3d 427, 1997 WL 16031 (Fed. Cir. 1997), (per curiam)(unpublished), cert. denied, 118 S. Ct. 60 (1997) (“The existence of mental steps in the claims or specification of a patent do not, in and of themselves, invalidate the patent.”). No case cited in the Examiner’s Response to Arguments even remotely supports a reason (ii) that precludes use of a pencil and paper—there is no such standard for statutory subject matter.

G. Section 102(e) Rejection**G.1. Claims 49-62**

Claims **49-62** stand rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,014,645 issued to Cunningham ("Cunningham").

We respectfully traverse the Examiner's Section 102(e) rejection. The Examiner has not established a *prima facie* case of anticipation of Claims **49-62**.

G.1.a. Independent Claims 49, 61 and 62

We respectfully submit that Claims **49, 61 and 62** are not anticipated by Cunningham. Cunningham does not teach or suggest all of the features of any of independent Claims **49, 61 and 62**.

As we best understand the Office Action, the Examiner asserts the following to be true with respect to independent Claims **49, 61 and 62**:

Cunningham discloses:

- *calculating a payment, wherein the payment is based on a modification of the parameter from the first value to the second value*
- *providing an offer to a customer associated with the credit account, wherein the offer comprises an offer to provide the payment to the customer if the customer agrees to the modification of the parameter*

We respectfully traverse these assertions.

We note that the Examiner was unable in the Telephone Interview to support the assertions in the Office Action as to what Cunningham teaches. Specifically, the Examiner could not find support in the cited portions (Col. 5, lines 6-67; Fig. 3; Col. 6, lines 1-11; Fig. 4) for anything related to *a payment, an offer to provide a payment to a customer, or an offer to provide a payment to the customer if the customer agrees to the modification of the parameter*.

As discussed with the Examiner during the Telephone Interview, we have carefully reviewed the entire Cunningham reference, without finding a teaching or suggestion of:

(i) *calculating a payment, wherein the payment is based on a modification of a parameter from the first value to the second value, or*

(ii) providing an offer to provide the payment to the customer if the customer agrees to the modification of the parameter

as generally recited in each of Claims **49, 61 and 62**.

The Examiner has not established a *prima facie* case of anticipation of independent Claim **49** (or Claims **50-60** dependent therefrom) or independent Claims **61 and 62**. We respectfully request that the Examiner withdraw the Section 102(e) rejection of Claims **49-62**.

G.1.b. Claim 50

The Examiner has not established a *prima facie* case of anticipation of Claim **50**.

Cunningham cannot anticipate Claim **50**. Specifically, if Cunningham does not teach in which the offer is to provide a payment to the customer if the customer agrees to the modification (discussed above), it cannot teach *receiving acceptance of such an offer*. We respectfully request that the Examiner withdraw the Section 102(e) rejection of Claim **50**.

G.1.c. Claim 51

The Examiner has not established a *prima facie* case of anticipation of Claim **51**.

Cunningham cannot anticipate Claim **51**. Specifically, if Cunningham does not teach wherein the payment is based on a modification of a parameter from a first value to a second value or calculating such a payment (as discussed above), it cannot teach receiving *providing such a payment to the customer*. We respectfully request that the Examiner withdraw the Section 102(e) rejection of Claim **51**.

G.1.d. Claim 58

The Examiner has not established a *prima facie* case of anticipation of Claim **58**.

Cunningham cannot anticipate Claim **58**. Specifically, if Cunningham does not teach wherein the payment is based on the modification of the parameter from the first value to the second value (as discussed above), it cannot teach *calculating the payment based on the modification and information associated with the customer*. We respectfully request that the Examiner withdraw the Section 102(e) rejection of Claim **58**.

G.2. Claims 63-74

Claims **63-74** stand rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,131,810 issued to Weiss ("Weiss").

We respectfully traverse the Examiner's Section 102(e) rejection. The Examiner has not established a *prima facie* case of anticipation of Claims **63-74**.

G.2.a. Claims 63-69 and 71-72 are cancelled

For at least the reasons indicated in our previous Response (incorporated herein), we respectfully submit that Claims 63-69 and 71-72 are not anticipated by Weiss. However, Claims 63-69 and 71-72 have been cancelled without prejudice by this Amendment. Accordingly, the Section 102(e) rejection of Claims 63-69 and 71-72 is moot.

G.2.b. Independent Claims 70, 73 and 74

Independent Claims **70, 73 and 74** have been amended.

Independent Claim **70** now incorporates all of the limitations of cancelled Claim 63.

All of independent Claims **70, 73 and 74** now recite features generally directed to:

- *determining a payment to offer to the customer in exchange for modifying the at least one term*
- *wherein the offer to modify the at least one term of the credit account includes an offer of the payment*

The Examiner asserts that Weiss discloses all of these features in Fig. 5M and associated text (see Office Action, page 8). We respectfully traverse this assertion.

There is nothing in Fig. 5M, the associated text, or otherwise in Weiss that would remotely suggest a payment to offer the customer, much less a payment to offer in exchange for modifying the at least one term, much less wherein the offer to modify the at least one term of the credit account includes an offer of the payment.

Claims **70, 73 and 74** each also include a feature generally directed to *presenting the customer with an offer to modify the at least one term of the credit*

account. During the Telephone Interview the Examiner was unable to indicate where in Fig. 5M and accompanying text Weiss discloses such a feature.

Accordingly, the Examiner has failed to establish a *prima facie* case of anticipation of any of Claims **70, 73 and 74** and we respectfully request that the Examiner withdraw the Section 102(e) rejection of Claims **70, 73 and 74**.

G.3. credit account not limited to existing credit account; customer not limited to established customer

The present Examiner essentially repeats the same bases for rejection under § 102(e) that were provided in the Office Action of a previous Examiner. In our Response (mailed May 4, 2004) to the previous Office Action (mailed January 6, 2004), we included several arguments as to why the cited Cunningham and Weiss references did not teach or suggest all of the features of any of the independent claims.

We maintain our previous arguments that neither Cunningham nor Weiss (either alone or in combination) teaches all of the features of any claim, as discussed above.

In arguing against the previous Examiner's rejections in our prior Response we stated:

In contrast, Cunningham is directed to attaining new customers. It is devoid of any hint of altering any term of an existing account....

[page 13]. We also stated:

Customer dissatisfaction with an existing account is not mentioned at all in Weiss. Weiss discusses a process by which a new customer is introduced to various types of integrated accounts offered by a bank. [Column 12, lines 58-62]. FIGS. 5A-5M and accompanying text, which are cited and relied upon by the Examiner, describe how a new customer may select and build an account-the new customer is not associated with any account.... As there is no hint in Weiss of determining that an existing customer is dissatisfied....

[page 14].

We clarify for the record that the statements above, when read in the context of all arguments previously made, should not suggest, for example, that the recited *credit account* and *customer* in independent Claims **49, 61-63, 73 and 74** are somehow limited (e.g., limited to only existing credit accounts and /or customers). On the contrary, the present claims unequivocally embrace additional

embodiments, such as those involving the establishment of new accounts or customers.

Accordingly, although the language of Claims **49-74** (and new Claims **75-79**) encompasses embodiments related to existing credit accounts (as discussed in the prior Response, pages 12-13, 14), *credit account* is not limited to only existing credit accounts, and may refer to a new or existing account. Similarly, *customer* is not limited to only an established or existing customer, and may refer to, for example, a new or potential customer.

We reiterate for the benefit of the Examiner and the public: With respect to Claims **49-79**, we are not disclaiming from the scope of coverage subject matter related to credit accounts or customers that are not existing or established.

Fortunately, the present Examiner does not appear to have relied upon (or even acknowledged) any of the above-specified statements. As the present Examiner repeated the same bases for rejection and made all of the rejections final it is clear that the prior arguments had no bearing on the patentability of the claims.

H. New Claims 75-80 Contain Allowable Subject Matter

Each of new Claims **75-80** is allowable over the cited Cunningham and Weiss references.

Each of new Claims **75-79** depends from independent Claim **70** and is believed to be allowable for at least the reasons that Claim **70** is allowable.

New independent Claim **80** recites features not even hinted at by either cited reference. The cited references do not teach or suggest any features of:

- *determining a current value for a parameter of an existing credit account*
- *providing an offer to the customer, in which the offer comprises an offer to provide the payment to the customer if the customer agrees to a modification of the parameter from the current value to the value that is not the same as the current value*
- *receiving an indication that the customer agrees to the modification*
- *providing the payment to the customer after receiving the indication*

Specifically, as discussed above with respect to Claims **49, 61, 62, 70, 73 and 74**, nothing in either Weiss or Cunningham suggests *an offer to provide a payment to a customer if the customer agrees to a modification of a parameter of a credit account (much less of an existing credit account), much less receiving an indication of agreement to such a modification.*

Further, nothing in either Weiss or Cunningham suggests *a modification of a parameter of an existing credit account.*

Accordingly, we submit that all of new Claims **75-80** are in condition for allowance.

I. Conclusion

It is submitted that all of Claims **49-62, 70, and 73-80** are in condition for allowance. The Examiner's early re-examination and reconsideration are respectfully requested.

If the Examiner has any questions regarding this amendment or the present application, the Examiner is cordially requested to contact Michael Downs at telephone number (203) 461-7292 or via electronic mail at mdowns@walkerdigital.com.

If any additional extension of time is necessary, please grant a petition for the extension of time required to make this Response timely. Additionally, please charge any appropriate fees necessary for this response and application.

Charge account information:

Deposit Account: 50-0271

Order No.: 96-108-C2

Please credit any overpayment to the same account.

A duplicate copy of this authorization is enclosed for such purposes.

Respectfully submitted,

December 20, 2004

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